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09/774,990	01/30/2001	Anna Pia Slothower	PALM-3559.US.P	4362
7590 03/31/2009 WAGNER, MURABITO & HAO LLP Third Floor Two North Market Street San Jose, CA 95113			EXAMINER NGUYEN, JENNIFER T	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/774,990
Filing Date: January 30, 2001
Appellant(s): SLOTHOWER ET AL.

William A. Zarbis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/10/08 appealing from the Office action mailed 06/12/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,556,189

Takahata et al.

4-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (AAPA) Fig. 1 in view of Takahata et al. (U.S. Patent No. 6,556,189).

Regarding claims 1, 9, and 16, the AAPA Fig. 1 discloses an integrated enclosure/touch screen assembly comprising:

a display mechanism (140);

a digitizer mechanism comprising a protective component (120) and a resistive digitizing element (130); and

a cover (110) for the touch screen assembly that is disposed over and encloses said touch screen assembly, wherein the resistive digitizing element can be activated by contact made along the external surface of the cover (page 10, line 11 to page 11, line 10 in supported specification).

AAPA Fig. 1 differs from claims 1, 9, and 16 in that it does not specifically disclose the cover is a single piece cover enclosure that encloses the top and fully covers both sides of touch screen assembly that has endpoints that are coincident with a bottom surface of said touch screen, and wherein said single piece enclosure forms a seal to protect said touch panel.

Takahata teaches a cover is a single piece cover enclosure (43, fig. 10) that encloses the top and fully covers both sides of touch screen assembly (42) wherein the single piece cover enclosure(43) encloses the top for a touch screen assembly and wherein said single piece enclosure forms a seal to protect said touch panel (col. 10, lines 40-58, col. 11, lines 14-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the single piece cover enclosure as taught by Takahata in the system of the AAPA Fig. 1 in order to provide an outer packet to protect portion of the touch panel from damage. Although Takahata teaches the single piece cover enclosure has endpoints that are coincident with a side of said touch screen (fig. 10). However, the location of the endpoint is a matter of designer's choice and it would have been obvious to obtain the endpoints that are

coincident with a bottom surface of said touch screen in order to provide a safe and neat outer package housing the touch panel.

Regarding claims 2 and 17, the combination of the AAPA Fig. 1 and Takahata teaches a single piece cover enclosure is constructed using in mold decoration (col. 10, lines 40-58 of Takahata).

Regarding claim 3, the combination of the AAPA Fig. 1 and Takahata teaches a soft thermoplastic outer film is coupled to said protective component of said digitizer mechanism by in mold decoration to form said single piece cover enclosure (col. 10, lines 40-58 of Takahata).

Regarding claims 4 and 11, the AAPA Fig. 1 further teaches finger pressure on the external surface of said single piece cover enclosure can be used to activate said digitizer mechanism (page 10, line 11 to page 11, line 10 in specification).

Regarding claims 5 and 12, AAPA Fig. 1 teaches wherein stylus pressure on the external surface of said cover enclosure may be used to activate said digitizer mechanism (page 10, line 11 to page 11, line 10 in specification).

Regarding claim 6, the combination of the AAPA and Takahata teaches wherein said single piece cover comprises a mylar polycarbonate material (col. 10, lines 50-58).

Regarding claims 7, 14 and 20, the AAPA Fig. 1 further teaches the soft thermoplastic film has sufficient deflection under external pressure to active said digitizer mechanism (page 1, lines 15-20 in specification).

Regarding claims 8 and 15, the combination of AAPA Fig. 1 and Takahata teaches the single piece cover enclosure is constructed with a flat outer top surface free of any indentation (Figs. 1-10 of Takahata).

Regarding claims 10 and 19, the combination of AAPA Fig. 1 and Takahata teaches said single piece cover enclosure (43) is a soft thermoplastic outer film that is coupled to say top film of said digitizer mechanism (including in touch panel 42) that is coupled to the supporting structure (i.e., 8) (col. 5, lines 24-55 of Takahata).

Regarding claims 13 and 18, the AAPA Fig. 1 further teaches the digitizing element of said digitizer mechanism is a resistive type digitizing element (page 10, line 11 to page 11, line 10 in specification).

(10) Response to Argument

In response to Applicants' argument:

(i) The embodiments described in Takahata's Figures 9 and 11, even in combination with AAPA, also do not show or suggest the claimed structure. In these embodiments, the cover pieces are made up of multiple pieces; there is not a single cover piece that fully encloses the top and sides of the touch screen assembly, that has endpoints that are coincident with the bottom surface of the touch screen assembly, and that forms a seal, in contrast to the claims.

Examiner respectfully disagrees. Takahata teaches the cover piece is a single cover piece (43) that fully encloses the top and sides (figs. 9 and 10) of the touch screen assembly (42), that has endpoints (at seal 44 or fusing 45) that are coincident with the side surface of the touch screen assembly (42), and that forms a seal (col. 10, lines 40-58, col. 11, lines 14-27). Although Takahata teaches the single piece cover enclosure has endpoints that are coincident with a side of said touch screen (fig. 10). However, the location of the endpoint is a matter of designer's choice and it would have been obvious to obtain the endpoints that are coincident with a bottom surface of said touch screen in order to provide a safe and neat outer package housing the touch panel.

(ii) That is, as evidenced by Figure 10, Takahata's touch panel is completely enclosed by the surrounding bag 43; the bag has no endpoints and, as such, it has no endpoints that are coincident with the bottom surface of the touch screen assembly.

Examiner respectfully disagrees. Takahata teaches the bag (43) has open portion (figs. 9 and 10) and the sealing or fusing can be made at the open portion (col. 11, lines 14-19). Therefore, Takahata teaches the bag has endpoints

(iii) Appellant respectfully submits that there is no showing or suggestion in either AAPA or Takahata or the combination thereof of a cover piece that partially encloses yet seals a touch screen assembly in the manner claimed.

Examiner respectfully disagrees. Takahata teaches the sealing characteristic of the aforementioned adhered portion of the touch panel (42) can be improved by covering with the outer package (43) part of the periphery of the touch panel, not entire periphery (col. 11, lines 54-57). Furthermore, it would have been an obvious matter of design choice to relocate the endpoints of Takahata, since a such modification would have involved a mere change in the

location of a component. A change in location is generally recognized as being within the level of ordinary skill in the art In re Japikse, 86 USPQ 70 (CCPA 1950), since the operation of the device would not thereby be modified.

(iv) In response to Appellant's argument that the examiner's conclusion of obviousness of combination of AAPA and Takahata is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(v) None of Takahata's embodiments appear to show or suggest "a cover element... that has a top surface coincident with the top surface of a supporting structure... Takahata's bag 43 is not coincident with the top of a supporting structure, but instead appears to wrap around any supporting structure".

Examiner respectfully disagrees. Takahata teaches the cover element (6) that has a top surface coincident with the top surface of a supporting structure (i.e., sealing material 8 can be considered as a supporting structure that protect the other element of the touch panel, fig. 1). Takahata's bag 43 is on top surface of the touch panel so it is coincident with the top surface of the supporting structure.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Examiner, Art Unit 2629

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